

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): **LIEBERMAN, Philip**

For (title): **SYSTEM FOR SELECTIVE DISABLEMENT AND LOCKING OUT OF
COMPUTER SYSTEM OBJECTS**

Filing Date: **06/09/2004**

Examiner: **JUNG, David Yiuk**

Serial No: **10/709,965**

Art Unit: **2134**

Mail Stop Petition

Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia 22313-1450

**REQUEST FOR RECONSIDERATION OF PETITION UNDER 37 C.F.R. 1.48(a)
and alternately now under 37 C.F.R. 1.182-83**

Sir:

The DECISION ON PETITION (copy enclosed) under 37 C.F.R. 1.48(a) in this matter states:

37 C.F.R. 1.48(a) petitions to correct inventorship require ...(4) written consent of the assignee.

The written consent of the assignee (listed in the Assignment as Lieberman Software Corporation ...) is missing.

We respectfully urge that the decision to dismiss Applicant's petition is error and we request reconsideration. The submittal of the assignment by the assignee to the Office for Recordation is a *de facto* written consent of the assignee. Enclosed are copies of the two individual inventor assignments, the Recordation Form Cover Sheet that the assignee submitted to the Office with these when requesting recordation, and the Notice of Recordation subsequently issued by the Office. As can be seen in the inventor assignments, these are by both inventors and they clearly identify each as inventors. As can be seen from the Recordation Form Cover Sheet, the assignee has acknowledged/consented in a writing that both of the inventors are inventors. Furthermore, the Notice of Recordation is also a writing, and we urge that its acceptance by the assignee is a further written consent that the omitted inventor be treated as an inventor.

Other Remarks And Alternate Basis For Petition And Grant

For clarification of the record in this case, an additional written consent of the assignee is also provided herewith.

The intent of the inventors and the assignee in this matter cannot be in question. The failure to include a more formal form of written consent with the original petition in July 2004 was unfortunate, but it will not be the proximate cause here if the Office issues a patent that omits Nicholas M. Carroll as an inventor. That cause will be the Office's inaction in deciding Applicant's petition for over four years, and then only when prompted to do so at the urging of its own issuance branch and the Applicant. Both undersigned and the Office have made mistakes here, but it is the Office's errors that have prevented Applicant from becoming aware of this situation and correcting it earlier, and that have allowed this matter to become time critical.

If Applicant's petition is still felt to be not grantable under 37 C.F.R. § 1.48(a) we urge that it is alternately grantable under either of 37 C.F.R. § 1.182-83. We respectfully note that all formalities (e.g., timeliness, payment of official fees, etc) for this petition under any basis were dealt with in Application's original submittal on July 19, 2004.

Patent Venture Group
10788 Civic Center Drive, Suite 215
Rancho Cucamonga, California 91730-3805

Respectfully Submitted,



Raymond E. Roberts
Reg. No.: 38,597

Telephone: (909) 758-5145
Facsimile: (888) 847-2501

Application/Control Number: 10/709,965

Page 2

Art Unit: 2434

/Kambiz Zand/

Supervisory Patent Examiner, Art Unit 2132Raymond E. Roberts

Patent Venture Group

10788 Civic Center Drive, Suite 215

Rancho Cucamonga, CA 91730-3805

In re application of Lieberman et al. :
Serial No. 10/709,965 : DECISION ON PETITION
Filed: June 9, 2004 :
For: System for Selective Disablement :
and Locking Out of Computer :
System Objects :
:
:
:

This is a decision on the petition, filed July 26, 2004, to correct inventorship under 37 CFR 1.48(a).

37 CFR 1.48(a) petitions to correct inventorship require (1) a petition including a statement from each person being added as an inventor that the error in inventorship occurred without deceptive intention, (2) an oath or declaration by the actual inventors as required by 37 C.F.R. § 1.63, (3) the fee set forth in 1.17, and (4) written consent of the assignee.

The written consent of the assignee (listed in USPTO assignment record as Lieberman Software Corporation of 9107 Wilshire Boulevard Suite 450, Beverly Hills, CA 90210) is missing.

The petition is **dismissed**.

/David Y Jung/

Acting Examiner of Art Unit 2434

On October 14, 2008

David Jung, on behalf of TC 2400

Primary Examiner

Art Unit 2434

/Kambiz Zand/

Supervisory Patent Examiner, Art Unit 2434



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231



700100072

JULY 22, 2004

PTAS

INTELLECTUAL PROP. LAW OFFICES
RAYMOND E. ROBERTS
1901 S. BASCOM AVE.
SUITE 660
CAMPBELL, CA 95008

UNITED STATES PATENT AND TRADEMARK OFFICE
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 07/19/2004

REEL/FRAME: 014867/0751

NUMBER OF PAGES: 3

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

LIEBERMAN, PHILIP

DOC DATE: 06/06/2004

ASSIGNOR:

CARROLL, NICHOLAS M.

DOC DATE: 06/06/2004

ASSIGNEE:

LIEBERMAN SOFTWARE CORPORATION
9107 WILSHIRE BOULEVARD
SUITE 450
BEVERLY HILLS, CALIFORNIA 90210

SERIAL NUMBER: 10709965

FILING DATE:

PATENT NUMBER:

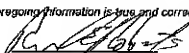
ISSUE DATE:

TITLE:

014867/0751 PAGE 2

SHARON LATIMER, EXAMINER
ASSIGNMENT DIVISION
OFFICE OF PUBLIC RECORDS

07/19/2004
700100072

Form PTO-1095 (Rev. 03/01) OMB No. 0651-0027 (exp. 5/31/2002)		RECORDATION FORM COVER SHEET PATENTS ONLY		U.S. DEPARTMENT OF COMMERCE U.S. Patent and Trademark Office	
Tab settings: [icon] [icon] [icon] [icon] [icon] [icon] [icon]					
To the Honorable Commissioner of Patents			Please record the attached original documents or copy thereof.		
1. Name of conveying party(ies): <u>Philip Lieberman and Nicholas M. Carroll</u>			2. Name and address of receiving party(ies) Name: <u>Lieberman Software Corporation</u> Internal Address: _____ _____ _____ Street Address: <u>9107 Wilshire Boulevard</u> <u>Suite 450</u> City: <u>Beverly Hills</u> State: <u>CA</u> Zip: <u>90210</u>		
Additional name(s) of conveying party(ies) attached? <input type="checkbox"/> Yes <input checked="" type="checkbox"/> No					
3. Nature of conveyance: <input checked="" type="checkbox"/> Assignment <input type="checkbox"/> Merger <input type="checkbox"/> Security Agreement <input type="checkbox"/> Change of Name <input type="checkbox"/> Other _____					
Execution Date: <u>July 6, 2004</u>			Additional name(s) & address(es) attached? <input type="checkbox"/> Yes <input checked="" type="checkbox"/> No		
4. Application number(s) or patent number(s): If this document is being filed together with a new application, the execution date of the application is: _____ A. Patent Application No.(s) <u>10709,965</u> B. Patent No.(s) _____ Additional numbers attached? <input type="checkbox"/> Yes <input checked="" type="checkbox"/> No					
5. Name and address of party to whom correspondence concerning document should be mailed: Name: <u>Raymond E. Roberts</u> Internal Address: <u>60748-300101</u> _____ _____ Street Address: <u>Intellectual Prop. Law Offices</u> <u>1901 S. Bascom Ave., Suite 660</u> City: <u>Campbell</u> State: <u>CA</u> Zip: <u>95008</u>			6. Total number of applications and patents involved: <input type="checkbox"/> 7. Total fee (37 CFR 3.41).....\$ <u>40.00</u> <input type="checkbox"/> Enclosed <input checked="" type="checkbox"/> Authorized to be charged to deposit account		
			8. Deposit account number <u>08-3240</u> _____ (Attach duplicate copy of this page if paying by deposit account)		
DO NOT USE THIS SPACE					
9. Statement and signature. To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document. <u>Raymond E. Roberts</u> Name of Person Signing  Signature <u>Jul 19, 2004</u> Date					
Total number of pages including cover sheet, attachments, and documents: <u>3</u>					

Mail documents to be recorded with required cover sheet information to:
 Commissioner of Patents & Trademarks, Box Assignments
 Washington, D.C. 20531

CH \$40.00 083240 10709965

ASSIGNMENT OF APPLICATION

Docket Number (Optional)

60748 300101

Whereas, I/We, Philip Lieberman of Beverly Hills, California, hereafter referred to as applicant, have invented certain new and useful improvements in System For Selective Disablement And Locking Out Of Computer System Objects

☒ for which an application for a United States Patent was filed on 9-Jun-2004

Application Number 10/709,965

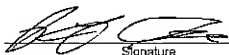
☐ for which an application for a United States Patent was executed on _____, and

Whereas, Lieberman Software Corporation of California here referred to as "assignee" whose mailing address is 9107 Wilshire Blvd., Suite 450, Beverly Hills, CA 90210 is desirous of acquiring the entire right, title and interest in the same;

Now, therefore, in consideration of the sum of ONE dollars (\$ 1.00), the receipt whereof is acknowledge, and other good and valuable consideration, I/We, the applicant(s), by these presents do sell, assign and transfer unto said assignee the full and exclusive right to the said invention in the United States and the entire rights, title and interest in and to any and all Patents which may be granted therefore in the United States. I/We hereby authorize and request the Director of the U.S. Patent and Trademark Office to issue said United States Patent to said assignee, of the entire right, title, and interest in and to the same, for his sole use and behoof; and for the use and behoof of his legal representatives, to the full end of the term for which said Patent may be granted, as fully and entirely as the same would have been held by me had this assignment and sale not been made.

Executed this 6 day of July, 20 04.

at Beverly Hills, California.


Signature

State of _____

SS:

Philip Lieberman

Printed Name/Registration No., if applicable

County of _____

Before me personally appeared said _____

and acknowledged the foregoing instrument to be his free act and deed this _____

day of _____, 20 _____.

Seal

Note: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required. See below.

☒ Total of 2 forms are submitted.

This form offers a sample or suggested format for an assignment document. This sample form is not an OMB officially approved form.

ASSIGNMENT OF APPLICATION

Docket Number (Optional)

60748.300101

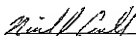
Whereas, I/We, Nicholas M. Carroll of Los Angeles, California, hereafter referred to as applicant, have invented certain new and useful improvements in System For Selective Disablement And Locking Out Of Computer System Objects

☒ for which an application for a United States Patent was filed on 9-Jun-2004
Application Number 10/709,965

☐ for which an application for a United States Patent was executed on _____, and
Whereas, Lieberman Software Corporation of California here referred to "assignee" whose mailing address is 8107 Wilshire Blvd., Suite 450, Beverly Hills, CA 90210 is desirous of acquiring the entire right, title and interest in the same;

Now, therefore, in consideration of the sum of ONE dollars (\$ 1.00), the receipt whereof is acknowledge, and other good and valuable consideration, I/We, the applicant(s), by these presents do sell, assign and transfer unto said assignee the full and exclusive right to the said invention in the United States and the entire rights, title and interest in and to any and all Patents which may be granted therefore in the United States. I/We hereby authorize and request the Director of the U.S. Patent and Trademark Office to issue said United States Patent to said assignee, of the entire right, title, and interest in and to the same, for his sole use and behoof; and for the use and behoof of his legal representatives, to the full end of the term for which said Patent may be granted, as fully and entirely as the same would have been held by me had this assignment and sale not been made.

Executed this 6 day of July, 20 04
at Beverly Hills, California



Signature

State of _____

Nicholas M. Carroll

County of _____

SS:

Printed Name/Registration No., if applicable

Before me personally appeared said _____

and acknowledged the foregoing instrument to be his free act and deed this _____

day of _____, 20 _____.

Seal

Note: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required. See below.

☒ Total of 2 forms are submitted.

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Docket No.: 60748.300101

Patent

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Examiner: **JUNG, David Yiuk**
Art Unit: **2134**

Honorable Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313

**WRITTEN CONSENT OF ASSIGNEE TO ADDITION OF
UNINTENTIONALLY OMITTED INVENTOR 37 C.F.R.1.48(a),
AND STATEMENT UNDER 37 C.F.R. 3.73(b)**

LIEBERMAN SOFTWARE CORPORATION

Formerly of:


9107 Wilshire Boulevard, Suite 450
Beverly Hills, California 90210

Presently of:

1900 Avenue of the Stars, Suite 425
Los Angeles, California 90067

The assignment at reel/frame 014867/0751 in the records of the Office assigns the entire right, title and interest in this invention to Lieberman Software Corporation. Assignee hereby consents to the correction of inventorship filed on July 19, 2004.

11/1/08
(date)


Philip Lieberman
President, Lieberman Software Corporation